UNITED STATES PATENT AND TRADEMARK OFFICE

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09/690,368	10/16/2000	Tracey L. Jones	1005.11	3107

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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _12 November 2009_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,2,5-10,13-18,21-24,28-30 and 34-51_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,2, 5-10,13-18,21-24,28-30 and 34-51_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the amendment received 11/12/2009.

2.   Claims 1, 2, 5-10, 13-18, 21-24, 28-30, 34-36, 40-42, and 46-51 are pending in the

application. Claims 1, 9, and 17 are independent claims.

3.   The rejection of claims, 2, 5-10, 13-18, 21-24, 26, 28-30, 32, 34-36, 38, 40-42, and 46-51

under 35 U.S.C. 102(e) as being anticipated by Rosenoff have been withdrawn pursuant to

applicant's amendments.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   **Claims 1, 2, 5-10, 13-18, 21-24, 28-30, 34-36, 40-42, and 46-51 are rejected under 35**

U.S.C. 103(a) as being unpatentable over Rosenoff et al., USPN 7,003,719 filed (1/25/1999)

in view of Melen et al., USPN 6,263,121 filed (9/16/1998).

In reference to independent claim 1, Rosenoff teaches:

'*storing an electronic version of a paper, the electronic version being displayed on a*

display device as a likeness of a paper

at a first location within the electronic version, detecting a reference to a second

location, wherein the second location is external to the paper, and wherein the detected

referenceat the first location is associated with a portion of the likeness, and wherein the

detected reference at the first location is other than alphanumeric characters of the associated

portion of the likeness; and

   in response to the detected reference at the first location, embedding a hyperlink within

the associated portion of the likeness, wherein the hyperlink is selectable at the first location

by a user to cause an operation associated with the second location; and

   while the first location is displayed on the display device, highlighting the first location

to indicate the hyperlink as being selectable at the first location by the user to cause the

operation associated with the second location'.

   A means of manipulating documents through a processor such as letters, resumes,

research papers, and legal briefs. The software automatically locates and marks specific portions

of a document and defines hyperlinks including at least a portion of the marked text. See column

1, lines 13-29 and column 2, lines 40-67.

   The reference further teaches a means of detection at a first location terms that refer to a

second location that is external to the document. The detected reference is found through the use

of a tokenizer which encapsulates information within the found object. See figure 2 and column

6, lines 29-67. The reference describes a method for finding and marking legal citations, for

example, references to court opinions, government laws, and legal treatises. The method

automatically defines each hyperlink to include at least a portion of a marked legal citation. The

reference fails to include specific language that provides for the detection of first location is

other than alphanumeric characters of the associated portion of the likeness. The reference to

Melen provides for the scanning of paper documents and attribute processing of scanned

documents which suggests the detection of a first location, other than alphanumeric characters of

the associated portion of the likeness. More specifically, the reference to Melen provides a

attribute processor that searches and detects attribute values within a document for eventual

creation of hyperlinks. See column 4, lines 1-67, column 5, lines 1-67, column 7, lines 1-54. The

examiner is interpreting the phrase 'detected reference at the first location is associated with a

portion of the likeness' broadly through the teachings of the attribute processor of Melen.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to have combined the alphanumeric detection methods of Rosenoff with the attribute

processing methods of Melen because it would have given the user the added benefit of utilizing

the structured document processing techniques for indexing formatted documents.

The link builder object as described in the reference to Rosenoff discloses a means of

defining and inserting hyperlinks into the detected reference at the first location. See column 9,

lines 34-67 and column 14, lines 35-67. A selection of the hyperlink would cause an operation

related to the second location.

The exemplary document illustrated in figure 1 includes portions which have been

marked, for example, visibly in contrasting color or font, to signify its association with an

existing hyperlink. See column 4, lines 50-67.

In response to dependent claim 2, Rosenoff teaches:

When a citation is located, the content-finder object creates a found object, which

encapsulates the information for the found citation, and passes the found object to the client via a

content-finder event object through an outgoing event interface. The client can indicate what

types of cites they want to locate, as well as setting other options that control how the cites are

located. See column 6, lines 45-67 and column 7, lines 1-67.

In reference to dependent claim 5, Rosenoff teaches:

Short forms are considered any citation that is referenced using the terms id, ibid, infra or supra. Short-form list also stores the location of each short form reference in the document. See column 9, lines 45-67.

In reference to dependent claim 6 and 7, Rosenoff teaches:

General examples of suitable document-processing software include word-processing programs, HTML-editing programs, spread-sheet programs, presentation-development programs, browsing programs, which allow for manipulations of documents such as minimizing and maximizing documents. See column 4, lines 26-49.

In reference to dependent claim 8, Rosenoff teaches:

The exemplary document illustrated in figure 1 includes portions which have been marked, for example, visibly in contrasting color or font, to signify its association with an existing hyperlink. See column 4, lines 50-67.

In reference to independent claims 9, 10, 13-16, the limitations recite language related to a system for performing similar steps as those found in claims 1, 2, 5-8, respectively. Therefore, the claims are rejected under similar rationale.

In reference to independent claims 17, 18, 21-24, the limitations recite language related to a computer program product for performing similar steps as those found in claims 1, 2, 5-8, respectively. Therefore, the claims are rejected under similar rationale.

In reference to dependent claim 26, Rosenoff teaches:

A means of identifying page numbers related to reference locations. See column 7, lines 5-67.

In reference to dependent claim 28, Rosenoff teaches:

In the HTML implementation, the integration object creates the HTML tokenizer and passes it into the citefinder object. The HTML implementation is utilized to translate a first version of a citation into an electronic version which contains links to specific content. See column 5, lines 21-67.

In reference to dependent claim 29, Rosenoff teaches:

The integration object takes the URL from the link-builder object and instructs document processing software to insert a hyperlink including the URL over the range of text encompassing the foundation. The method continues with activities related to generating a table of authorities or other found content collection and creates a table of authorities. See column 14, lines 51-67.

In reference to dependent claim 30, Rosenoff teaches:

The exemplary document illustrated in figure 1 includes portions which have been marked, for example, visibly in contrasting color or font, to signify its association with an existing hyperlink. See column 4, lines 50-67.

In reference to dependent claim 34, 35, 36, 38, 40-42, the limitations recite language related to a system for performing similar steps as those found in claims 1, 2, 5-8, 21-24, respectively. Therefore, the claims are rejected under similar rationale.

In reference to dependent claim 46, 48, and 50, Rosenoff teaches:

If a statute-like publication has not already been round, then the processor checks to see if this is a cite that starts with a statute keyword. The processor tries to locate a valid statute keyword. Further statute processing entails trying to match all completed statute like cites to those found in the match cite list. See column 13, lines 25-67.

In reference to dependent claim 47, 49, 51 Rosenoff teaches:

A means of manipulating documents through a processor such as letters, resumes, research papers, and legal briefs. The software automatically locates and marks specific portions of a document and defines hyperlinks including at least a portion of the marked text. See column 1, lines 13-29 and column 2, lines 40-67.

The reference further teaches a means of detection at a first location terms that refer to a second location that is external to the document. The detected reference is found through the use of a tokenizer which encapsulates information within the found object. See figure 2 and column 6, lines 29-67.

Response to Arguments

6.   Applicant's arguments with respect to claim 1, 2, 5-10, 13-18, 21-24, 28-30, 34-36, 40-42, and 46-51 have been considered but are moot in view of the new ground(s) of rejection. Applicant amended the claims and introduced new language into the independent claims thus changing the scope of the invention when the claims are read as a whole. The rejections of the claims have been modified to adjust for the newly added language.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MATTHEW J. LUDWIG whose telephone number is (571)272-

4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen S. Hong/
Supervisory Patent Examiner, Art Unit
2178

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